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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,932	03/01/2002	Kenneth J. Myers	BEU/MYER3014	7129

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EXAMINER	
CZEKAJ, DAVID J	
ART UNIT	**PAPER NUMBER**
2613	

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/084,932	MYERS, KENNETH J.	
	Examiner	Art Unit	
	Dave Czekaj	2613	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 January 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) *21 and 22* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 May 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claim 2 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 8 of copending Application No. 10/122386. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Specification

3. The disclosure is objected to because of the following informalities: On page 12, lines 18 and 20 and page 14, lines 6 and 9, the "steps" cannot be found in the corresponding figures.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 4-5, 7, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Osterweil et al. (6567682), (hereinafter referred to as "Osterweil").

Regarding claims 1-2, 4-5, 7, and 17, Osterweil discloses an apparatus that relates to an optical apparatus (Osterweil: column 1, lines 14-20). This apparatus comprises "capturing a composite image of a background object and foreground pattern at a first distance" (Osterweil: figures 6-7, column 3, lines 61-65, wherein the camera captures the image, the background object is the ulcer, the pattern is the grid), "capturing a composite image of the background and foreground situated at a second distance from an image plane" (Osterweil: column 12, lines 7-11, wherein the camera changes its x, y, and z coordinates), and "comparing the relative sizes of features of the background object and foreground pattern relative to a fixed set of coordinates" (Osterweil: column 8, lines 60-65, wherein the comparison is done in the three-dimensional correlation).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 3, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osterweil et al. (6567682), (hereinafter referred to as "Osterweil").

Regarding claim 3, note the examiners rejection for claim 1, and in addition, claim 3 differs from claim 1 in that claim 3 further requires the capturing steps to be performed simultaneously. Although not disclosed, it would have been obvious to capture the images simultaneously (Official Notice). Doing so would have been obvious in order to make the throughput of the system more efficient by being able to capture two images at once.

Regarding claim 6, note the examiners rejection for claims 2-3.

Regarding claim 8, Osterweil discloses "the camera further includes at least one beam splitter for splitting an image of the background object" (Osterweil: figure 1, wherein the beam splitter is the mirror).

8. Claims 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osterweil et al. (6567682), (hereinafter referred to as "Osterweil") in view of Vernackt (6804388).

Regarding claim 9, note the examiners rejection for claim 1, and in addition, claim 9 differs from claim 1 in that claim 9 further requires the pattern to be situated on the beam splitter. Vernackt teaches that placing the pattern on the beam splitter eliminates an error caused by viewing the registration target at an angle (Vernackt: column 7, lines 21-30, wherein the beam splitter is the plate). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to take the apparatus disclosed by

Osterweil and add the pattern placement taught by Vernackt in order to obtain an apparatus that operates more efficiently by reducing errors in the system.

Regarding claims 10 and 12, although not disclosed, it would have been obvious to etch the pattern into the mirror (Official Notice). Doing so would have been obvious in order to display a consistent pattern throughout many images.

Regarding claim 11, Vernackt discloses "a mirror having an adjustable angle" (Vernackt: column 5, lines 57-60, wherein the mirror is mounted on a pivot which serves to rotate the mirror achieving an adjustable angle).

Regarding claims 13-14, Osterweil discloses "at least one foreground pattern is situated between the beam splitter and the receiver" (Osterweil: figure 5, wherein the pattern is generated by the pattern generator, the receiver is the image which receives the pattern from the pattern generator).

Regarding claims 15-16, although not disclosed, it would have been obvious to have a variety of number of patterns, receivers, and beam splitters (Official Notice). Doing so would have been obvious in order to make the apparatus more versatile by being able to adapt to many different types of environments.

9. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osterweil et al. (6567682), (hereinafter referred to as "Osterweil") in view of Alumot et al. (5982921), (hereinafter referred to as "Alumot").

Regarding claims 18-20, note the examiners rejection for claim 1, and in addition, claims 18-20 differ from claim 1 in that claims 18-20 further requires

capturing images at selected wavelengths that differ from a set of wavelengths to which the first and second receivers are responsive. Alumot teaches that prior art inspection systems are extremely slow (Alumot: column 1, lines 31-35). To help alleviate this problem, Alumot discloses "capturing a composite image of the background image at a selected wavelength that differ from a set of wavelengths to which the first and second receivers are responsive" (Alumot: column 26, lines 8-10, wherein the beam splitter only reflects the infrared portion of the light). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to take the apparatus disclosed by Osterweil and add the different wavelength capturing taught by Alumot in order to obtain an apparatus that operates more efficiently by increasing processing speed.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US-6222624	04-2001	Yonezawa, Eiji
US-5461452	10-1995	Iwasaki, Hiroyuki
US-5679161	10-1997	Wysokowski et al.
US-6079862	06-2000	Kawashima et al.
US-6320173	11-2001	Vock et al.
US-6326994	12-2001	Yoshimatsu, Hiroshi
US-6434255	08-2002	Harakawa, Kenichi

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Czekaj whose telephone number is (571) 272-7327. The examiner can normally be reached on Monday - Friday 9 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CHRIS KELLEY
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